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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/508,407	09/21/2004	Jesse Gaytan	47519	6207

1609 7590 11/12/2008

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EXAMINER	
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ART UNIT	PAPER NUMBER
1615	

MAIL DATE	DELIVERY MODE
11/12/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/508,407	GAYTAN, JESSE	
	Examiner	Art Unit	
	Jeffrey T. Palenik	1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *19 May 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-34* is/are pending in the application.

4a) Of the above claim(s) *1-18* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *19-34* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *21 September 2004*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

RESPONSE TO REMARKS

The Examiner thanks the Applicant for their timely reply filed on 21 May 2008, in the matter of 10/508,407.

The supplemental reply filed on 19 September 2008 was not entered because supplemental replies are not entered as a matter of right except as provided in 37 CFR 1.111(a)(2)(ii). The Office may enter a supplemental reply as a matter of right if the supplemental reply is clearly limited to one or more of the reasons as listed in MPEP §714.03(a). In the instant case, the present application has received two replies from two different parties on two separate days in response to the same Office Action dated 21 March 2008. Since there has been no documentation filed indicating that a change in the Power of Attorney has occurred, the Examiner deems this to be an instance which falls outside the scope of the aforementioned conditions regarding Supplemental Amendments. Thus the second response, dated 19 September 2008, will not be entered and the response dated 21 May 2008 and the claims amended by the current attorney(s) of record will be examined on the merits.

The amendment made to claim 30 clarifying its statutory category as a composition as opposed to a method is acknowledged by the Examiner. Herein, the claim will be reorganized into and considered with Group II (claims 19-29 and 31-34).

Applicant's election **with traverse** of Group II (claims 19-34) is acknowledged. Applicant traverses the lack of unity requirement on the grounds that "the milling process

referred to [in Chan (WO 91/11104)] was in the context of specifying dimensions for other insecticides that could be mixed with the ORTHENE® insecticide".

Applicant's request for reconsideration of the restriction requirement has been fully considered by the Examiner and **is persuasive**. Upon further consideration of the claims submitted by Applicant, a new requirement follows. However, as noted above, amended claim 30 is included in the claims to Group II, formerly designated as claims 19-29 and 31-34. Regardless, the claims still do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same corresponding technical feature. There is no special technical feature since Example 6 of Chiba et al. (USPN 5,190,764) teaches the instantly claimed granular composition comprising the phosphoroamido(di)thioate compound acephate (e.g. ORTHENE®), wherein the acephate composition used is 98.5% pure and said particles have a mean diameter of 30 microns. and further comprising corn starch as a binder (see Granule B in Table 1A, col. 9), wherein the granular mixture is compacted into a tablet.

Claims 1-18 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a non-elected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction requirement between the compositions and methods.

The remaining claims 19-34 are presented and represent all claims under consideration.

INFORMATION DISCLOSURE STATEMENT

An Information Disclosure Statement (IDS) filed 21 September 2004 is acknowledged and has been reviewed.

Specification

Applicant is reminded of the proper content of an abstract of the disclosure.

A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains. If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure. If the patent is in the nature of an improvement in an old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement. In certain patents, particularly those for compounds and compositions, wherein the process for making and/or the use thereof are not obvious, the abstract should set forth a process for making and/or use thereof. If the new technical disclosure involves modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.

The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.

Where applicable, the abstract should include the following:
(1) if a machine or apparatus, its organization and operation;
(2) if an article, its method of making;
(3) if a chemical compound, its identity and use;
(4) if a mixture, its ingredients;
(5) if a process, the steps.

Extensive mechanical and design details of apparatus should not be given.

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the

disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. **It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.**

CLAIM REJECTIONS - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 19-34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 19 recites the limitation “particle size distribution” within its limitations. Said limitation renders the instant claims indefinite, particularly since it is not clear to which dimension (i.e. length, width or diameter) Applicant’s claims are directed.

Claims 20-30 recite the limitation "said solids have a particle size..." in each of the claims. There are insufficient antecedent bases for this limitation in each of the claims because it is unclear which particle size limitation recited in the independent claim 19 (i.e. (a) or (b)) is being further defined. Herein, and for the purposes of examination on the merits the Examiner broadly and reasonably interprets the “size” limitations of claims 20-30 as further limiting the size limitations recited in option (b) of claim 1.

CLAIM REJECTIONS - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 19 and 24-32 are rejected under 35 U.S.C. 102(b) as being anticipated by Chiba et al. (USPN 5,190,764).

The instant claims are directed to a compacted granular composition of milled phosphoroamidodithioate solids wherein said solids have been milled to have a particle size distribution wherein at least 67% of the solids have a size between 4.6-88 microns (claims 19 and 24-32). This limitation is interpreted broadly and reasonably by the Examiner as the granular composition being composed of at least 67% phosphoroamidodithioate solids (i.e. at least 67 pure phosphoroamidodithioate solids) and as having an average particle diameter between 4.6-88 microns. With regard to the limitations recited in claims 24 and 25, which state that the "solids have a particle size having a standard deviation of less than 35 μm" or "...less than 30 μm", respectively; until some material differences in the properties of the composition are demonstrated, said limitations are considered by the Examiner to be directed toward the instant granular composition of claim 19. The limitations wherein the granules have been produced either by milling or jet-milling as recited in claims 19 and 26-30, are deemed by the Examiner as product-by-process limitations, which per MPEP §2113, are considered as holding no patentable weight. Regarding the limitations recited in claims 28-30 wherein the

compacted granules have (e.g. comprise) "less than 14 wt%", "less than 13 wt%" or "less than 11 wt% of said [granular solids] have a size within the range of 44-88 μm", the Examiner broadly and reasonably interprets each of these limitations as reading on the granules comprising 0 wt% of particles within the range of 44-88 μm. Regarding the limitations recited in claims 31 and 32, which state that the "said granules have a bulk density of at least 450 g/L" or "...about 450 g/L to about 650 g/L", respectively; until some material differences in the properties of the composition are demonstrated, said limitations are considered by the Examiner to be directed toward the instant granular composition of claim 19.

Example 6 of Chiba et al. specifically teaches the instantly claimed phosphoroamidodithioate solid acephate (e.g. ORTHENE®) as having been prepared via milling, as having a purity of 98.5% and a mean particle diameter of 30 microns. The Example is also silent to any weight percentages of milled solid particles produced, which range in size from 44-88 microns. Thus the Examiner interprets this silence as an express teaching of less than the instantly claimed 11%, 13%, and/or 14% by weight of milled phosphoroamidodithioate solid particles which range in size from 44-88 microns. The milled acephate having a purity of 98.5% is interpreted as the milled product comprising 98.5 wt% of acephate. Claim 2 teaches a sustained release pesticide comprising solid pesticidal particles wherein each of said particles comprises a core of a solid pesticidal active ingredient, and a coating comprising a layer of fine hydrophobic particles. Chiba further expressly teaches compressing the hydrophobic substance and the fine pesticide

particles into tablet form as the best mode for working the sustained release pesticide (col. 5, lines 32-36).

CLAIM REJECTIONS - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 19-34 rejected under 35 U.S.C. 103(a) as being unpatentable over Chiba et al. (USPN 5,190,764).

The instant claims are directed to a compacted granular composition comprising phosphoroamidodithioate solids of a particular size distribution, as discussed above. Claims 19-22 further limit the average size range of the milled solids recited in claim 19. Claim 33 recites that the compacted phosphoroamidodithioate granules comprise a binder, a particulate flow aid (i.e. a lubricant) and the phosphoroamidodithioate species acephate. Claim 34 further limits the binder of claim 33 to a polyethylene oxide polymer.

The teachings to Chiba are discussed above. Chiba further teaches that the compositions taught in claim 2 and Examples 6 and 7, may further comprise auxiliary additives. Such additives include lubricants such as metal salts of stearates (e.g. magnesium stearate) (col. 5, lines 50-60) as well as polyethylene oxide polymers (e.g. anionic surfactants) such as polyethylene glycol ethers and esters (col. 10, lines 1-12). Claims 12, 18 and 19 also teach various size range limitations for the pesticide particles of the composition, the broadest of which ranges from 0.01-100 microns.

Chiba does not expressly teach particles formed within the more narrowly recited size ranges.

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to obtain granules of a phosphoroamidodithioate solid such as acephate which have a particular milled size distribution, combine said particles with a lubricant and a polyethylene oxide polymer, as taught and suggested by Chiba, and produce the instantly claimed invention.

One of ordinary skill in the art would have been highly motivated to do this because Chiba expressly teaches forming granules using a pesticide active ingredient such as acephate (Examples 6 and 7) and further teaches in claims 2 and 8, a particulate composition comprised of said active and auxiliary lubricants such as metal salt stearates. Other auxiliary binder additives such as polyethylene glycol polymers are taught as being used to help create the end product, which is preferably taught as a compression-formed tablet (col. 5, lines 32-36).

As mentioned above, the reference does not expressly teach the narrow ranges of milled particles sizes, as claimed by Applicant. Since the values of each parameter with respect to the claimed composition are adjustable, it follows that each is a result-effective parameter that a person having ordinary skill in the art would routinely optimize. Optimization of parameters is a routine practice that would be obvious for a person of ordinary skill in the art to employ. As evidenced by claims 12, 18 and 19 of Chiba, the size of the pesticide particles produced may range as broadly as 0.01-100 microns. Thus, it would have been customary for an artisan of ordinary skill, to adjust the size of the milled phosphoroamidodithioate solids of the compacted granules to reflect narrower ranges such as 15-23 microns, in order to achieve the desired granule formulation. Thus, absent some demonstration of unexpected results from the claimed parameters, optimization of any of these parameters would have been obvious at the time of Applicants' invention.

From the teachings of the reference, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in producing the claimed invention. Therefore, the invention as a whole was *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the reference, especially in the absence of evidence to the contrary.

All claims have been rejected; no claims are allowed.

CORRESPONDENCE

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey T. Palenik whose telephone number is (571) 270-

1966. The examiner can normally be reached on 7:30 am - 5:00 pm; M-F (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on (571) 272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jeffrey T. Palenik/
Examiner, Art Unit 1615

/MP WOODWARD/
Supervisory Patent Examiner, Art Unit 1615